

## **REMARKS/ARGUMENTS**

### **A. Background**

Claims 1-10 and 12-21 are pending in the application.

In the Office Action, the Examiner indicated that Claims 1-10, 12-15 and 18-20 are allowed.

The Examiner rejected Claims 16-17 and 21 under 35 U.S.C. 103(a) as being unpatentable over Borovoy et al. (U.S. Patent No. 5,873,107) in view of Dutta (U.S. Patent No. 6,636,854). Reconsideration is respectfully requested in view of the following remarks. Accordingly, claims 16-17 and 21 are presented for the Examiner's reconsideration.

### **B. Rejections under 35 U.S.C. 103(a)**

The Examiner rejected Claims 16-17 and 21 under 35 U.S.C. 103(a) as being unpatentable over Borovoy et al. (U.S. Patent No. 5,873,107) in view of Dutta (U.S. Patent No. 6,636,854). Reconsideration is respectfully requested.

Dutta received a filing date of December 7, 2000

Submitted herewith is a Declaration Under Section 1.131, executed by the inventors, indicating that they invented the subject matter covered by the amended claims (as presented above) prior to December 7, 2000, the filing date of Dutta (U.S. Patent No., 6,636,854). The Examiner's reliance on Dutta as an obviating reference under Section 103(a) is overcome by such declaration.

As supported by the enclosed declarations, the subject matter covered by claims 16-17 and 21 was invented at least prior to December 7, 2000. As evidence of such prior invention, U.S. Provisional Patent Application No. 60/204,245 entitled "Methods and

Systems for User Activated Automated Searching” is attached to the inventors declarations. Such provisional application was placed on file May 15, 2000, well before the filing date of Dutta. (131 Decl. ¶ 2; Exh. B.)

As set forth in the attached 131 declaration, inventors May 15, 2000 provisional application was unintentionally not converted to a conventional application, and therefore lapsed one year following the filing date. The inventors became aware of such lapse shortly thereafter and directed counsel to prepare and file a nonprovisional application with the United States Patent and Trademark Office (“PTO”). (131 decl. ¶ 3.)

Counsel immediately began preparation of the nonprovisional application. The nonprovisional application was able to be drafted, reviewed by the inventors, finalized and placed on file in the PTO in less than two and a half weeks, namely June 6, 2001. (131 decl. ¶ 4.) It is respectfully suggested, that each party involved in the preparation and filing of the nonprovisional application was clearly diligent in light of the short time between recognizing the unintentional lapse and filing the nonprovisional application.

As evidence to establish that the inventors were in possession of the claimed invention, the Examiner is respectfully directed to the provisional application attached to the inventors Section 131 declaration. For ease of analysis, the Examiner is specifically directed to claims 1, 2, 11, and 16 and the specification of the provisional application, which clearly demonstrate possession of the subject matter claimed in the present rejected claims.

In that Applicant has sufficiently demonstrated completion of the invention prior to the effective date of Dutta, Applicant respectfully suggests that the Examiner’s 103

rejection has been overcome and claims 16-17 and 21 are now in a condition for prompt allowance.

C. Conclusion

In view of the response and amendments submitted herein, Applicant respectfully submits that each of the pending claims is in condition for allowance. Therefore, reconsideration of the rejections is requested and allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully invited to initiate the same with the undersigned attorney.

Respectfully submitted,



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